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In re Application of :
Goddard et al. :
Serial No.: 10/063,518 : PETITION DECISION
Filed: May 1, 2002 :
Attorney Docket No.: 10466/303 :

This is in response to the petition under 37 CFR § 1.183, filed April 26, 2007 requesting that the Information Disclosure Statement and SB08 equivalent form which includes 25 U. S. patent applications among the listed references be entered into the above referenced application. The delay in acting upon this petition is regretted.

DISCUSSION

Petitioner requests the entry of the Information Disclosure Statement (IDS) and SB08 equivalent form which includes 25 U. S. patent applications among the listed references. Petitioner argues that each of the patent applications listed in the IDS serve as the basis of a priority claim in U.S. Patent Application Serial No. 09/488,725, which is also listed on the accompanying SB08 equivalent form. U.S. Patent Application Serial No. 09/488,725 served as the basis of a priority claim in PCT Publication WO 01/53312, which served as the basis of a rejection under 35 U.S.C. §102(e) in the Office Action mailed January 11, 2007 in related application 10/063,518.

Each of the listed patent applications other than Serial Nos. 09/471,275 and 09/488,725 are unpublished and unavailable to Petitioner. In addition, petitioner states that each of these applications is "likely to contain a large sequence listing" (this is unclear as it can easily be determined that they do). Petitioner argues that the PTO is believed to have copies of each of the listed applications, as well as electronic copies of the sequence listings therefrom.

Petitioner argues that in view of the unavailability of the listed patent applications and the fact that the electronic forms of the sequence listings therefrom are more usable to the PTO than paper copies, that the requirement for submitting a paper copy of the each of the listed patent applications and the sequence listings therefrom be waived in the above identified application and any application claiming priority thereto.

Petitioner has provided copies of the specifications of Serial Nos. 09/471,275 and 09/488,725. However, these applications contain sequence listings with over 10,000 sequences therein.

The petition contains two requests, namely, (1) waiver of the requirement to provide copies of unpublished patent applications cited on the SB08 equivalent form, and (2) waiver of the requirement to provide paper copies of the sequence listings of two abandoned patent applications.

Petitioner's arguments with regard to the first request are not found persuasive. Petitioner is requesting that the Office do indirectly what 35 U.S.C. 122 does not permit applicant to do directly, that is make available to applicant (and the public) information that (another) applicant is entitled to have remain in confidence. Should the petition be granted, the Office would need to make such material available in the instant application, which is open to the public because the instant application was published on January 9, 2003. Preservation of confidentiality of unpublished abandoned patent applications is governed by 37 CFR 1.14 (a) (1) (iv) which states, in part, the file contents of an unpublished, abandoned application may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under 35 U.S.C. 119(e), 120, 121, or 365 in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, or an international patent application that was published in accordance with PCT Article 21(2). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request, and payment of the appropriate fee (§ 1.19(b)).

In accordance with the above, and the fact that Serial Nos. 09/471,275 and 09/488,725 are in the priority chain of PCT Publication WO 01/53312, the Office will provide copies of said applications upon request and payment of the appropriate fee. However, permitting petitioner to cite unpublished applications in an information disclosure statement without copies is inappropriate since it would force the Office to break the confidentiality of the unpublished applications. The Office is permitted to do this only under the circumstances listed above.

Thus, the request to waive of the requirement to provide copies of unpublished patent applications cited on the SB08 equivalent form is **DENIED**.

With regard to the second request, waiver of the requirement to provide paper copies of the sequence listings of two abandoned patent applications, petitioner's arguments are deemed persuasive.

The standard for granting a § 1.183 petition is the existence of an extraordinary circumstance where justice requires the relief requested. The petition establishes the existence of such an extraordinary situation. The Office has been publishing large sequence listings for some time because such has been deemed in the interests of the public and the Office. Forcing petitioner to submit paper copies would be contrary to the established procedures. This position is further supported by 37 CFR 1.14 (2)(b) which states, "Where a copy of the application file or access to the application may be made available pursuant to this section, the Office may at its discretion provide access to only an electronic copy of the specification, drawings, and file contents of the application." This seems tailor-made for provision of electronic sequence listings.

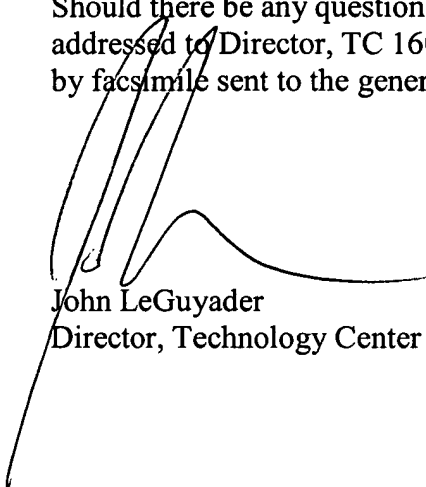
Thus, the request to waive the requirement to provide paper copies of the sequence listings of two abandoned patent applications is **GRANTED**.

DECISION

The petition is **GRANTED-IN-PART**. The IDS will be entered and the examiner is instructed to line through the citations to unpublished abandoned applications for which no copies have been provided. The examiner is instructed to consider Serial Nos. 09/471,275 and 09/488,725 and refer to the sequence listings of the instant case since they are the same as in the above applications.

Any new or renewed petition must be filed within TWO MONTHS of the mailing date of this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



John LeGuyader
Director, Technology Center 1600